IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Steven Allen Benno	Group Art Unit:	2645
Serial No.:	10/783,308	Examiner:	Simon P. Sing
Filed:	February 20, 2004	Atty. Dkt. No.:	2100.025500
		Client Docket:	BENNO 5-2-1-1-3-1-2
For:	Telephone Systems	Confirmation No:	7814

REVISED APPEAL BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby submits this Revised Appeal Brief to the Board of Patent Appeals and Interferences in response to the Notice of Non-Compliant Appeal Brief dated December 11, 2006. The fee for filing this Appeal Brief has been previously paid. However, should additional fees be required the Commissioner is authorized to deduct said fees from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/2100.025500/SKS.

A Notice of Appeal was filed on August 10, 2006, thus making an Appeal Brief due on October 10, 2006. Pursuant to 37 C.F.R. § 1.136(a), Applicant petitions for an extension of time of one month to and including November 10, 2006 in which to respond to the Office Action dated June 28, 2006. Accordingly, the Commissioner is authorized to deduct the extension fee ($120) required under 37 C.F.R. § 1.16 to 1.21 from Williams, Morgan & Amerson, P.C. Deposit Account No. 50-0786/2100.025500/sks.

I. REAL PARTY IN INTEREST

The present application is owned by Lucent Technologies, Inc.

II. RELATED APPEALS AND INTERFERENCES

Applicant's representative(s), and the Assignee are not aware of any appeals, interferences, or judicial proceedings that are related to, may be affected by, might affect. or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-4, 6-19, 21-24 are pending in the instant application. Claims 1-4, 6-19, and 21-24 are at issue in this appeal and they are attached as Appendix A. Claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24 stand rejected in the Final Office Action issued on May 16, 2006 under 35 U.S.C. § 102(e) as allegedly being anticipated by ***Lund*** (U.S. Patent No. 6,658,100). Claims 8, 14 and 23 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ***Lund***. Rejections of claims 2, 13 and 18 under 35 U.S.C. § 112 and of claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24 under U.S.C. § 102(e) have been withdrawn by the Examiner in the Advisory Action dated July 28, 2006. All the pending claims 1-4, 6-19 and 21-24 are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

An Amendment as to matters of form has been filed subsequent to the Final Office Action. Applicant believes that this amendment has been entered by the Examiner.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In general, the present invention is directed to communication systems, and more particularly, to spreading codes. There are five independent claims at issue in the current appeal: claims 1, 9, 15, 17 and 24.

Independent claim 1 is generally directed to a method of communication between at least a calling-from-party and a calling-to-party. The method comprises transmitting a uniform resource locator to the calling-from-party in response to an initiation signal from the calling-from-party, determining if the calling-to-party is a service subscriber, and establishing a voice link to the calling-to-party in response to the initiation signal from the calling-from-party. By way of example only, at least portions of the invention are described at p. 4-16; Figures 1-6.

Independent claim 9 is generally directed to a method of communication with a calling-to-party. The method comprises receiving a uniform resource locator associated with the calling-to-party in response to an initiation signal from a calling-from-party, enabling the calling-from-party to determine whether the calling-to-party is a service subscriber, and establishing a first data session in response to the received uniform resource locator. By way of example only, at least portions of the invention are described at 4-16; Figures 1-6.

Independent claim 15 is generally directed to a method of communication with a calling-from-party. The method comprises selecting multimedia content associated with a calling-to-party to be forwarded to the calling-from-party in response to identifying the calling-to-party, determining if the calling-to-party is a service subscriber, and establishing a voice link from the calling-from-party to the calling-to-party in response to the identifying the calling-to-party. By way of example only, at least portions of the invention are described at 4-16; Figures 1-6.

Independent claim 17 is generally directed to a method of communication between at least a calling-from-party and a calling-to-party. The method comprises receiving an initiation signal from the calling-from-party identifying the calling-to-party, transmitting multimedia content to the calling-from-party, the multimedia content selected in response to identifying the calling-to-party, determining if the calling-to-party is a service subscriber, and establishing a voice link to the calling-to-party in response to the initiation signal form the calling-from-party. By way of example only, at least portions of the invention are described at 4-16; Figures 1-6.

Independent claim 24 is generally directed to a method of communication between at least a calling-from-party and a calling-to-party. The method comprises receiving an initiation signal from the calling-from-party identifying the calling-to-party, transmitting a uniform resource locator to the calling-from-party, the uniform resource locator selected in response to identifying calling-to-party, transmitting multimedia content in response to the uniform resource locator, determining if the calling-to-party is a service subscriber, establishing a voice link with the calling-to-party in response to the initiation signal, and bridging the initiation signal from the calling-from-party using the established voice link to the calling-to-party. By way of example only, at least portions of the invention are described at 4-16; Figures 1-6.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant respectfully requests that the Board review and overturn the rejections present in this case. The following issues are presented on appeal in this case:

A) Whether claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24 are anticipated by ***Lund*** under 35 U.S.C. §102(e).

B) Whether claims 8, 14, and 23 are obvious over ***Lund*** under 35 U.S.C. 103(a).

VII. ARGUMENT

Appellant respectfully submits that the Examiner erred in rejecting claims 1-4, 6-19, 21-24. Applicant respectfully requests that the rejection of claims 1-4, 6-19 and 21-24 over ***Lund*** be reversed.

A. Claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24 Are Allowable Over Lund

As the Board well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. M.P.E.P. § 2131.

In the Office Action mailed May 16, 2006, claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,658,100 to Lund (hereinafter "***Lund***") and U.S. Patent No. 6,480,484. Applicant respectfully disagrees. The Examiner's position is flawed for multiple reasons, as set forth below.

Independent claim 1 calls for, among other things, determining if the calling-to-party is a service subscriber and establishing a voice link to the calling-to-party in response to the initiation signal from the calling-from-party. The Examiner alleges that ***Lund*** teaches all the elements of claim 1. The Applicant respectfully disagrees and asserts that ***Lund*** at least does not teach or suggest determining if the calling-to-party is a service subscriber when a voice link to the calling-to-party is established in response to an initiation signal from a calling-from-party.

In the Advisory Office Action mailed on July 28, 2006, the Examiner asserts that ***Lund*** determines if the caller's number and the called number are valid. Thus, according to the Examiner a test to "determine validity of a called party's telephone number" corresponds to a test to "determine whether the caller and called party are subscribers to a **basic** telephone **service**." Contrary to the Examiner's conclusary statement, such a determination of validity of a

called party's telephone number by ***Lund*** does not indicate if the called party is a service subscriber. For instance, the called party may have an additional or different phone number(s) than the one determined to be invalid. Thus, even when the called party's telephone number tests to be an invalid number, that party can still a service subscriber to one or more services, such as the basic telephone service and/or value added services, *e.g.*, including caller ID, call forwarding, and call block, remains to be the service subscriber. In other words, a called party having a telephone number is by default assumed to have a basic telephone service based on its unique telephone number *albeit* currently invalid or non-operational. Thus, determining the validity of a called party's telephone number, as described by ***Lund,*** is not the **same as** determining if the calling-to-party is a service subscriber and establishing a voice link to the calling-to-party in response to the initiation signal from the calling-from-party. In other words, a subscription may be checked for a service other than a basic telephone service such as a value-added service, which is essentially enabled by dialing or calling an existing valid telephone number of the called party.

Accordingly, given an exemplary scenario, in ***Lund***, dialing a telephone number merely triggers a check as to whether the dialed number is operational and not a check for whether it is a valid number of the called or calling-to-party. That is, at most, ***Lund*** determines whether an already issued telephone number is an operational number, but not whether it is a valid number for the calling-to-party. Accordingly, merely determining whether a telephone number is operational is not determining whether the calling-to-party is a service subscriber of that dialed telephone number. Since ***Lund*** queries a service database for retrieving only a called party's information to determine how to handle the call, and what services to provide the caller and the calling-to-party, it does not and need not either determine whether the calling-to-party is a

service subscriber to a basic telephone service or perform a subscription check of another service for the calling-to-party based on its subscription information. Based on the above legal standard, therefore, ***Lund*** fails to teach or suggest all the claimed features of claim 1.

The Examiner further argues that it is well known in the art that in a public switched telephone network (PSTN), when a caller dials a called party's telephone number, the PSTN queries a database to determine if the caller's number and the called number are valid (whether the caller and called party are subscribers to a telephone service), and what kind of service(s) (such as a basic service, and/or value added services, e.g. caller ID, call forwarding, call block, etc.) are subscribed to by the caller and the called party. The Examiner further alleges that ***Lund*** discloses a PSTN and teaches querying a service control point (SCP)'s database 44 to retrieve a called party's information (column 3, lines 23-25) to determine how to handle the call, and what services to provide the caller and the called party (column 3, lines 34-40). In this way, according to the Examiner, since ***Lund*** determines what services to provide the called party, it inherently determines what services the called party has subscribed, *i.e.*, determines whether the called party is a subscriber to one or more services provided by the PSTN. See the Advisory Office Action (Page 2).

As can be seen, this reasoning by the Examiner is flawed for many reasons. A closer review of ***Lund*** reveals that ***Lund*** collects a number of the called party to connect the called party with the calling party using the number of the called party. See ***Lund***, col. 5, lines 25-36. To communicate information about the called party to the calling party, a database is accessed to retrieve an address for locating a customized file of the called party for use by the calling party's device. However, ***Lund*** **uses functionality** information about the calling party and **the dialed number** to determine what services to provide the calling and called parties. See ***Lund***, col. 3,

lines 35-38. For example, in ***Lund***, a service control point (SCP) 40 determines whether the customer premises equipment (CPE) 106 of the calling party can display a webpage. See ***Lund***, col. 3, lines 40-43. That is, whether the called party is a service subscriber is not determined by the SCP 40, but rather **availability of** a particular functional **feature for** the calling party is **determined** in response to accessing a database to retrieve an address for a customized file of the called party. Thus, the Examiner's rejection is erroneous because ***Lund*** teaches away from determining if the calling-to-party is a service subscriber and establishing a voice link to the calling-to-party in response to the initiation signal from the calling-from-party. In applying ***Lund***, the Examiner asserts that to provide a webpage of a called party to a calling party, the called party's information is retrieved to determine what other services are subscribed by the called party in addition to determining whether the called party's number is valid. ***Lund***, however, is inconsistent with the suggestions of the Examiner. In particular, ***Lund*** describes quite the opposite, as set forth above. ***Lund***, on the other hand, determines what services to provide the called party using information about the originating caller and the dialed number. See ***Lund***, Col. 3, lines 35-39. Thus, not only does ***Lund*** not provide the teachings in the manner suggested, it actually teaches away from the claimed features of claim 1. For this reason at least, the Examiner's rejection is flawed.

Lund determines "what services" to provide to the called or calling-to-party, but it is distinct from determining "whether to provide certain services" to the called or calling-to-party based on a subscription check. In other words, ***Lund*** fails to determine if the calling-to-party is a service subscriber because the latter involves checking of subscription information. ***Lund*** is silent with regard to such a test since it is concerned with only providing particular functionality of available service(s). Based on the above-indicated legal standard, it is respectfully submitted

that ***Lund*** fails to anticipate claim 1 since ***Lund*** determines the services associated with the called party instead of its status as a user or subscriber of certain services. Thus, claim 1 and claims dependent therefrom are in condition for allowance, which is respectfully requested of the Examiner.

Lund is directed to automatically retrieving and displaying supplemental information about a called party on the customer premise equipment (CPE) of a calling party. By using a universal resource locator (URL) the customer premise equipment of the calling party retrieves the homepage of the called party from the Internet. See Abstract of ***Lund***. In this way, ***Lund*** allows the called party to communicate in a more detailed way with callers based on the supplemental information about the called party. The URL is an example of the supplemental information about the called party. See ***Lund***, col. 1, lines 41-56.

Lund fails to teach one or more of the claimed features. For example, ***Lund*** at least does not teach determining if the calling-to-party is a service subscriber. In contrast, ***Lund*** determines whether to make available the URL of the called party to the calling party for displaying its webpage. As stated in ***Lund***, application software resident in the CPE of the calling party uses its URL to retrieve the homepage of the called party.

While ***Lund*** teaches providing a particular, available service functionality to the called party or calling-to-party, such as retrieving the URL of the called party being stored in the database 44, ***Lund*** does not teach determining if the calling-to-party is a service subscriber. Accordingly, ***Lund*** fails to teach one or more of claimed features of claim 1.

For at least the reasons set forth above, independent claim 1 and claims dependent therefrom are not anticipated by ***Lund***. Accordingly, the board is respectfully requested to reverse the rejection of claim 1 and its dependent claims. For at least the aforementioned

reasons, independent claims 9, 15, 22, and 24 and their respective dependent claims are not anticipated by ***Lund***. Therefore, claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24 are allowable and the board is respectfully requested to reverse the rejection of claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24.

B. Claims 8, 14, and 23 Are Allowable Over Lund under 35 U.S.C. §103(a)

In the Office Action, claims 8, 14, and 23 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ***Lund***. However, as discussed above, in the context of §102 rejections of claim 1, ***Lund*** does not teach or suggest each and every element of the claims from which claims 8, 14 and 23 depend.

As the Board well knows, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Further, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of

ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. M.P.E.P. § 2142.

It is respectfully submitted that the pending claims are not obvious in view of ***Lund***. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. ***Lund*** fails to describe or suggest the limitations of claim 1 discussed above. Further, ***Lund*** does not teach or suggest transmitting a uniform resource locator by establishing a second data session for transmitting the uniform resource locator (URL) to the calling-from-party, as set forth in independent claim 8.

Absent improper hindsight, the cited references also fail to provide any suggestion or motivation to modify the prior art to arrive at Applicant's claimed invention. To the contrary, ***Lund*** teaches away from the present invention. In particular, ***Lund*** teaches that the customer Premises Equipment (CPE) of the calling party retrieves the homepage of the called party by using a URL. Accordingly, ***Lund*** teaches that the called party does not transmit the URL to the calling party. See ***Lund***, col. 3, ll. 19-28 and col. 4, ll. 8-14. ***Lund*** therefore teaches away from transmitting a uniform resource locator by establishing a second data session for transmitting the uniform resource locator (URL) to the calling-from-party. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious.

For at least the aforementioned reasons, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case that the present invention is obvious over ***Lund***. Applicant

requests that the Examiner's rejections of claims 8, 14, and 23 under 35 U.S.C. 103(a) be reversed.

VIII. CLAIMS APPENDIX

The claims that are the subject of the present appeal – claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24 are set forth in the attached "Claims Appendix."

IX. EVIDENCE APPENDIX

There is no separate Evidence Appendix for this appeal.

X. RELATING PROCEEDINGS APPENDIX

There is no Related Proceedings Appendix for this appeal.

XI. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the Examiner's assertions that the inventions defined in claims 1-4, 6, 7, 9-13, 15-19, 21, 22 and 24 are anticipated by ***Lund*** are misplaced. Similarly, the Examiners assertions that claim 8, 14 and 23 are obvious over ***Lund*** are also misplaced. It is respectfully submitted that the Examiner erred in not allowing all claims pending in the present application over the prior art of record. That is, Appellant respectfully submits that ***Lund*** does not disclose the entirety of the instant invention set forth in independent claims 1, 9, 15, 17, and 24 or the claims depending therefrom. Accordingly, Appellant respectfully requests that the Board review and overturn the §102 and §103 rejections present in this case.

For at least the aforementioned reasons, Appellant respectfully requests the Board reverse the Examiner's rejections of all the pending claims. The undersigned agent may be

contacted at (713) 934-4089 with respect to any questions, comments or suggestions relating to this appeal.

Please date stamp and return the enclosed postcard to evidence receipt of this document.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON

Date: December 19, 2006

/Sanjeev K. Singh, Ph.D./
Sanjeev K. Singh, Ph.D.
Reg. No. L0220
10333 Richmond, Suite 1100
Houston, Texas 77042
(713) 934-4089 ph
(713) 934-7011 fx

AGENT FOR APPLICANT

CLAIMS APPENDIX

1. (Previously Presented) A method of communication between at least a calling-from-party and a calling-to-party, the method comprising:

transmitting a uniform resource locator to the calling-from-party in response to an initiation signal from the calling-from-party;

determining if the calling-to-party is a service subscriber; and

establishing a voice link to the calling-to-party in response to the initiation signal from the calling-from-party.

2. (Original) The method of Claim 1, comprising:

bridging the initiation signal form the calling-from-party with the established voice link to the calling-to-party.

3. (Original) The method of Claim 2, wherein the uniform resource locator identifies a location of a multimedia content.

4. (Original) The method of Claim 3, wherein the step of transmitting a uniform resource locator comprises:

establishing a first data session for downloading the multimedia content.

5. (Cancel)

6. (Previously Presented) The method of Claim 3, wherein the step of determining the calling-to-party is a service subscriber comprises:

looking up the calling-to-party in a data base of service subscribers.

7. (Original) The method of Claim 6, wherein the step of transmitting a uniform resource locator comprises:

selecting the uniform resource locator if the calling-to-party is at least one of the service subscribers in the database.

8. (Original) The method of Claim 4, wherein the step of transmitting a uniform resource locator comprises:

establishing a second data session for transmitting the uniform resource locator to the calling-from-party;

terminating the established second data session in response to the step of establishing a voice link to the calling-to-party; and

terminating the established first data session after the step of terminating the established second data session.

9. (Previously Presented) A method of communication with a calling-to-party, the method comprising:

receiving a uniform resource locator associated with the calling-to-party in response to an initiation signal from a calling-from-party;

enabling the calling-from-party to determine whether the calling-to-party is a service subscriber; and

establishing a first data session in response to the received uniform resource locator.

10. (Original) The method of Claim 9, wherein the step of receiving a uniform resource locator comprises:

establishing a second data session for receiving the uniform resource locator.

11. (Currently Amended) The method of Claim 10, wherein the uniform resource locator identifies a location for multimedia content to be received over the ~~second~~ first data session.

12. (Currently Amended) The method of Claim 11, wherein the multimedia content is received over the ~~second~~ first data session if the calling-to-party is a service subscriber.

13. (Original) The method of Claim 12, comprising:

bridging the initiation signal from the calling-from-party into a voice link from the calling-from-party to the calling-to-party.

14. (Original) The method of Claim 13, comprising:

terminating the established second data session prior to the step of bridging the initiation signal; and

terminating the established first data session after the step of terminating the established second data session.

15. (Previously Presented) A method of communication with a calling-from-party, the method comprising:

selecting multimedia content associated with a calling-to-party to be forwarded to the calling-from-party in response to identifying the calling-to-party;

determining if the calling-to-party is a service subscriber; and

establishing a voice link form the calling-from-party to the calling-to-party in response to the identifying the calling-to-party.

16. (Original) The method of Claim 15, wherein the multimedia content is selected if the calling-to-party is a service subscriber.

17. (Previously Presented) A method of communication between at least a calling-from-party and a calling-to-party, the method comprising:

receiving an initiation signal from the calling-from-party identifying the calling-to-party;

transmitting multimedia content to the calling-from-party, the multimedia content selected in response to the identifying of the calling-to-party;

determining if the calling-to-party is a service subscriber; and

establishing a voice link to the calling-to-party in response to the initiation signal from the calling-from-party.

18. (Original) The method of Claim 17, comprising:

bridging the initiation signal form the calling-from-party with the established voice link to the calling-to-party.

19. (Original) The method of Claim 17, wherein uniform resource locator identifies a location for the selected multimedia content to be received from, and the step of transmitting multimedia content comprises:

transmitting a uniform resource locator; and

establishing a first data session for the transmission of the multimedia content.

20. (Cancel)

21. (Previously Presented) The method of Claim 19, wherein the step of determining if the calling-to-party is a service subscriber comprises:

looking up the calling-to-party in a database of service subscribers.

22. (Original) The method of Claim 21, wherein the step of transmitting a uniform resource locator comprises:

selecting the uniform resource locator if the calling-to-party is at least one of the service subscribers in the database.

23. (Original) The method of Claim 19, wherein the step of transmitting a uniform resource locator comprises:

establishing a second data session for transmitting the uniform resource locator to the calling-from-party;

terminating the established second data session in response to the step of establishing a voice link; and

terminating the established first data session after the step of terminating the established second data session.

24. (Previously Presented) A method of communication between at least a calling-from-party and a calling-to-party, comprising:

receiving an initiation signal from the calling-from-party identifying the calling-to-party;

transmitting a uniform resource locator to the calling-from-party, the uniform resource locator selected in response to the identifying the calling-to-party;

transmitting multimedia content in response to the uniform resource locator;

determining if the calling-to-party is a service subscriber;

establishing a voice link to the calling party in response to the initiation signal; and

bridging the initiation signal from the calling-from-party with the established voice link to the calling-to-party.